

APR 21 2009

60,469-254
OT-5282IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Kulak, Richard
Serial Number: 10/574,653
Filed: 04/04/2006
Group Art Unit: 3654
Examiner: Kruer, Stefan
Confirmation No.: 7623
Title: ELEVATOR ROLLER GUIDE WITH VARIABLE
STIFFNESS DAMPER

REPLY BRIEF

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in reply to the Examiner's Answer mailed on March 17, 2009.

Appellant has already addressed why the Examiner's proposed combination cannot be made and does not provide the result suggested by the Examiner. The Examiner is misconstruing the teachings of both of the references.

In the Examiner's Answer, the Examiner contends that the conductive coil 59 of the *Hollowell, et al.* reference is a damper whose stiffness is increased when an associated elevator car is at a landing. As already pointed out by Appellant, what the reference actually teaches is that the electrically conductive coil 59 is energized to force the platform 28 rigidly to the building by generating a "net forward force." (Column 4, lines 1-4, 16-20 and 60-64) It is not a reasonable interpretation of a force actuator to be construed as a damper. Generating a net forward force to move an elevator car is a different procedure than providing damping to absorb movement of an elevator car.

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The Examiner contends that "It would have been obvious to one of ordinary skill in the art to modify the reference of *Fujita* with the teaching of *Hollowell, et al.* for ergonomics and marketability." (Examiner's Answer, page 5) That statement is not based on the actual teachings of the references. As already explained in Appellant's opening brief, the *Fujita* reference is not capable of generating a net forward force according to the teachings of the *Hollowell, et al.* reference. Therefore, one skilled in the art would not see it obvious to modify the *Fujita* reference with the teachings of the *Hollowell, et al.* reference for "ergonomics and marketability" or any other reason for that matter. The teachings of the two references are incompatible with each other.

Moreover, on page 8 of the Examiner's Answer, the Examiner contends that "*Hollowell* teaches the concept of automatically increasing a resistance to lateral motion upon reaching a landing in anticipation of the forces/vibrations generated by disembarking/embarking passengers, wherein said concept can be applied to the controller of *Fujita*." The "concept" of the *Hollowell, et al.* reference is different than what the Examiner extracts from that reference. The "concept" of the *Hollowell, et al.* reference is to apply a net forward force for moving a car using force actuators. The *Fujita* reference includes passive dampers that are not capable of generating such a force. It therefore would require significant redesign of the arrangement of the *Fujita* reference, selective extraction of only a portion of the teachings from the *Hollowell, et al.* reference or both to somehow come up with the Examiner's proposed combination. In either case, the suggestion is based only on hindsight reasoning using Appellant's disclosure for determining how to extract a selected aspect of the *Hollowell, et al.* reference (divorcing that from the actual teachings of how that is accomplished in the reference) and then modifying the *Fujita* reference. Such an extrapolation can only be explained by hindsight reasoning, which of course, is not permitted for purposes of determining whether there is a *prima facie* case of obviousness.

In other words, the Examiner completely ignores the actual operation of the *Hollowell* reference, which is what the reference actually teaches to one skilled in the art without the benefit of Appellant's disclosure. It is not permissible to strain out some abstract "concept" from a reference and ignore how the reference actually teaches implementing that "concept" for purposes of attempting to manufacture a *prima facie* case of obviousness. Such an analysis is only based on hindsight reasoning because the reference does not provide any basis for that

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abstraction absent having the benefit of Appellant's disclosure and claims in the first instance.

There are guardians against hindsight reasoning including the explanations in MPEP 2143.01(VI). Guarding against improper hindsight includes checking whether a proposed modification would change the principle of operation of a reference. If so, there is no *prima facie* case of obviousness. In this case, the Examiner is completely changing the principle of operation of *Fujita's* passive damper by attempting to make it apply a force according to *Hollowell, et al.'s* control strategy. Alternatively, the Examiner is completely ignoring the express teachings of the *Hollowell, et al.* reference and using hindsight reasoning for reconstructing what the references actually teach to somehow come up with a combination that is consistent with Appellant's claimed invention. Either way, there is no *prima facie* case of obviousness.

The rejection must be reversed.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE

I hereby certify that this Reply Brief relative to Application Serial No. 10/574,653, is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on April 21, 2009.


Theresa M. Palmateer